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| 09/328,417 | 06/09/1999 | MANUEL A. CORREA JR | | 6806 |

7590 02/24/2005

WILLIAM D. HALL
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EXAMINER

COSIMANO, EDWARD R

| ART UNIT | PAPER NUMBER |
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3629

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/328,417

Applicant(s)

CORREA JR, MANUEL A.

Examiner

Edward R. Cosimano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 82,85-87,89-101 and 104-115 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 82,85-87,89-101 and 104-115 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. Applicant should note the changes to patent practice and procedure:
 - A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997;
 - B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000; and
 - C) Amendment in revised format, Vol. 1267 of the Official Gazette published February 25, 2003.
2. Applicant's claim for the benefit of an earlier filing data under 35 U.S.C. § 119(e) is acknowledged.
3. The proposed substitute/corrected drawings filed 26 November 2004 has been approved.
4. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).
5. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
 - (c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

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5.1 Claims 82, 85, 91, 93, 94, 97, 104 & 112-115 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Bowen et al (5,011,069) or Elmlinger (5,248,082) in view of either Van Malderghem (3,554,438) or Juszak et al (3,905,545) or Tess (4,023,727) or Swiercz (EP 0268410) as evidenced by Fowler et al (4,744,508).

5.1.1 In regard to claim 82, 91, 93, 94, 97, 104 & 112-115, either Bowen et al ('069) or Elmlinger ('082) disclose a multiple layer/ply mailer, where the first and second layers/plies are glued together in order to form a useable return envelope, a third layer/ply above the second layer/ply contains the bill/message, a fourth layer/ply above the bill/message layer/ply combined with the first layer/ply forms the out going envelope, and a fifth layer/ply above the fourth layer/ply that forms a removable cover sheet. Where information printed/applied on/to the cover sheet is selectively vertically transferred to the appropriate locations on the second/third/fourth layers/plies by using selectively applied image transfer coatings.

5.1.2 It is noted that in the mailers of either Bowen et al ('069) or Elmlinger ('082) both the out going envelope and the reply envelope are physically attached to one another at the time the out going envelope is mailed to the recipient. As the recipient opens the mailer of either Bowen et al ('069) or Elmlinger ('082), the recipient physically separates both the front cover of the out going envelope and statement sheet/page from the remaining parts of the mailer of either Bowen et al ('069) or Elmlinger ('082). This physical separation of the various parts of the mailer of either Bowen et al ('069) or Elmlinger ('082) would be understood by one of ordinary skill as:

A) physically destroying the out going envelope and thereby rendering the out going envelope useless; and

B) physically separates both the reply envelope from the out going mailer.

This would be the case even though the back of the out going envelope is reused as the back of the reply envelope in the mailers of either Bowen et al ('069) or Elmlinger ('082), since the out going envelope does not physically exist after it has been opened.

5.1.3 Neither Bowen et al ('069) nor Elmlinger ('082) disclose the use of two layer/plies to form the outgoing mailer and two other/separate layer/plies to form the return envelope, however as taught by either Van Malderghem ('438) or Juszak et al ('545) or Tess ('727) or

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Swiercz ('410) a multiple ply or layer mailer may be formed using at least 5 layers or plies, where the first ply/layer forms the back of the outgoing mailer, the top ply forms the front of the outgoing mailer, 2 consecutive plies/layer between the first and top plies/layers form the return envelope, and at least one additional ply/layer between the first and top plies/layers that is an information/statement sheet. However, as taught by Fowler et al ('508) it was known in 1988 that the multiple plies/layers of a mailer may form the various components of a mailer by using one ply of the mailer as part of the outgoing and return envelopes or two plies/layers that are separate from the layers/plies that form the outgoing mailer may be combined to form the return envelope. Hence, since it is known that the various components of a multiple ply/layer mailer may be formed in a number of different manners as taught by Fowler et al ('508), it would have been obvious to one of ordinary skill at the time of the invention, that the multiple ply/layer mailers of either Bowen et al ('069) or Elmlinger ('082) could be modified to include an additional interior ply/layer that when combined with another interior ply/layer would form the return envelope as taught by either Van Malderghem ('438) or Juszak et al ('545) or Tess ('727) or Swiercz ('410).

5.1.4 In regard to claim 85, since one of ordinary skill would not want the mailer of either Bowen et al ('069) or Elmlinger ('082) as modified by either Van Malderghem ('438) or Juszak et al ('545) or Tess ('727) or Swiercz ('410) to be destroyed by the postal processing equipment, it would have been inherent to one of ordinary skill at the time the invention was made that each of the layers/plies of either Bowen et al ('069) or Elmlinger ('082) must be made from a material that will survive any reasonably foreseeable potential damage that may be caused during process of delivering the outgoing and return mailing envelopes.

5.1.5 In regard to the line of weakness in claim 104, note at least line 66 as depicted in fig. 1 of Bowen et al ('069) or line 40 in fig. 1 of Elmlinger ('082).

5.2 Claims 87 & 98-101 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Bowen et al (5,011,069) or Elmlinger (5,248,082) as modified by either Van Malderghem (3,554,438) or Juszak et al (3,905,545) or Tess (4,023,727) or Swiercz (EP 0268410) as suggested by Fowler et al (4,744,508) as applied to claims 82, 85, 91, 93, 94, 97,

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104 & 112-115 and further in view of obvious considerations required by applicant's admitted requirements for processing mail and either Swiercz (EP 0268410) or .

5.2.1 In regard to claims 87 & 98 it is noted that the mailer of either Bowen et al ('069) or Elmlinger ('082) as modified by either Van Malderghem ('438) or Juszak et al ('545) or Tess ('727) or Swiercz ('410) as suggested by Fowler et al ('508) is for use in a postal system that uses various machines to aid in the process of processing and delivering mail. Since applicant admits that:

A) the Post Office requires a 90% readability of applied barcodes (see the last full paragraph of page 3);

B) the Post Office provides discounts for the application of information such as postal barcodes and facer identification marks (FIM) to items of mail (see the first full paragraph of page 2 and the paragraph bridging pages 2-3);

C) the Post Office uses optical character recognition (OCR) and barcode readers (BCR) to scan information applied to a mailing (see the paragraph bridging pages 1-2); and

D) the machines used by the Post Office to sort mail sometimes smears the applied barcodes so that the barcode is illegible, (see second full paragraph on page 1, "The present invention ... smeared by the post office processing equipment.");

it would have been obvious to one of ordinary skill at the time the invention was made that if the user of the mailer of either Bowen et al ('069) or Elmlinger ('082) as modified by either Van Malderghem ('438) or Juszak et al ('545) or Tess ('727) or Swiercz ('410) as suggested by Fowler et al ('508) were to apply barcodes to the out going and return envelopes to obtain a postal discount, then the applied barcodes and FIMs would be placed on the envelopes at a location which:

A) may be read by the equipment used by the Post Office;

B) is protected from being rendered or made useless/illegible by the equipment used by the Post Office; and

C) has suitable contrast with the background color of the mailer so as to aid in the recognition of the barcode.

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5.2.2 In regard to claims 99 & 100, it is noted that since applicant discloses that the use of FIMs reduces the associated postage costs, it would have been obvious to one of ordinary skill at the time the invention was made that the FIM applied to the out going envelope could be also applied to the return envelope using the transfer process of either Bowen et al ('069) or Elmlinger ('082) as modified by either Van Malderghem ('438) or Juszak et al ('545) or Tess ('727) or Swiercz ('410) as suggested by Fowler et al ('508).

5.2.3 In regard to claim 101, note above in regard to the teachings of either Bowen et al ('069) or Elmlinger ('082).

5.3 Claim 86, 89 & 90, are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Bowen et al (5,011,069) or Elmlinger (5,248,082) as modified by either Van Malderghem (3,554,438) or Juszak et al (3,905,545) or Tess (4,023,727) or Swiercz (EP 0268410) as suggested by Fowler et al (4,744,508) as applied to claims 82-85, 87, 91, 93, 94, 97-101, 104 & 112-115 and further in view of Fabel (4,461,661) and either Swiercz (EP 0268410) or Leibe (4,770,337).

5.3.1 In regard to claim 86, although either Bowen et al ('069) or Elmlinger ('082) as modified by either Van Malderghem ('438) or Juszak et al ('545) or Tess ('727) or Swiercz ('410) as suggested by Fowler et al ('508) does not disclose the bond of the paper used to form the various layers/plies, Fabel ('661) in the environment of making multi-ply mailers discloses a mailer composed of a number of attached layers/plies with selective carbon spotting to the multiple layers/plies in order to selectively transfer information applied to the top layer/ply to underlying layers/plies. Where Fabel ('661) further discloses that:

- A) two of the layers are combined to form the return mailing envelope;
- B) two of the layers are combined to form the outgoing mailing envelope;
- C) any suitable weight/bond of paper may be used for each layer/ply;
- D) a tear strip used to aid the recipient in opening the mailing.

5.3.2 Since each of Bowen et al ('069), Elmlinger ('082) and Fabel ('661) use similar mailers that are constructed in a similar fashion, and Fabel ('661) explicitly suggests:

- A) the need to use paper with sufficient weight/bond in order to obtain the desired result of the system of Fabel ('661); and

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B) the layers/plies of the mailing are bonded together;

it would have been obvious to one of ordinary skill at the time the invention was made that a user of the mailer of either Bowen et al ('069) or Elmlinger ('082) as modified by either Van Malderghem ('438) or Juszak et al ('545) or Tess ('727) or Swiercz ('410) as suggested by Fowler et al ('508) would use any suitable bonding means and weight/bond of paper to form each layer/ply of the mailer as taught by Fabel ('661) so as to form a complete mailer that is suitable for reaching the recipient and accomplishing the purpose of returning the reply of recipient to the original sender.

5.3.3 In regard to claims 88 & 90 and the reinforcing the right edge of the mailer so as to be processed by the mail processing equipment of the post office, since the mailer of either Bowen et al ('069) or Elmlinger ('082) as modified by either Van Malderghem ('438) or Juszak et al ('545) or Tess ('727) or Swiercz ('410) as suggested by Fowler et al ('508) as modified by Fabel ('661) must be strong enough to be processed by post office mail processing equipment without being damaged, it would have been obvious to one of ordinary skill at the time the invention was made that the leading edge of the mailer of either Bowen et al ('069) or Elmlinger ('082) as modified by either Van Malderghem ('438) or Juszak et al ('545) or Tess ('727) or Swiercz ('410) as suggested by Fowler et al ('508) as modified by Fabel ('661), as the mailer would be processed by the mail processing equipment of the post office, must be constructed/reinforced in such a fashion so as to be form a complete mailer that is suitable for reaching the recipient and accomplishing the purpose of returning the reply of recipient to the original sender as taught by Fabel ('661). See figs. 3 & 4 of Swiercz ('410) or fig. 2 of Leibe ('337) in which the leading edge or right hand side of the mailer receives more glue and hence would be stiffer and reinforced.

5.4 Claims 92, 95, 96, 105-108, 110 & 111 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Bowen et al (5,011,069) or Elmlinger (5,248,082) as modified by either Van Malderghem (3,554,438) or Juszak et al (3,905,545) or Tess (4,023,727) or Swiercz (EP 0268410) as suggested by Fowler et al (4,744,508) and as modified by Fabel (4,461,661) and either Swiercz (EP 0268410) or Leibe (4,770,337) as applied to claims 82,

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85-91, 93, 94, 97-101, 104 & 112-115 and further in view of either Dicker (4,157,759) or Ashby (5,039,000 or 5,163,612) and (In re Japikse, 86 U.S.P.Q. 70 @ 73 (CCPA, 1950)).

5.4.1 As per claims 92, 95, 96, 105-108, 110 & 111 and the use of a tear strip on the back of the mailer and positioned along the bottom of the mailer and that opens from the left side to the right side of the mailer. It is noted that although the mailer of either Bowen et al ('069) or Elmlinger ('082) as modified by either Van Malderghem ('438) or Juszak et al ('545) or Tess ('727) or Swiercz ('410) as suggested by Fowler et al ('508) and as modified by Fabel ('661) and either Swiercz ('410) or Leibe ('337) includes the use of tear strips to aid in opening the envelope, the mailer of either Bowen et al ('069) or Elmlinger ('082) as modified by either Van Malderghem ('438) or Juszak et al ('545) or Tess ('727) or Swiercz ('410) as suggested by Fowler et al ('508) and as modified by Fabel ('661) and either Swiercz ('410) or Leibe ('337) does not include the use of a tear strip that opens from left to right and is positioned on the back side of the mailer along the lower/bottom edge of the mailer. However, either Dicker ('759) or Ashby ('000 or '612) does disclose a multiple layer/ply mailer that includes the use of a tear strip that opens from left to right and is positioned along the lower/bottom edge of the mailer in order to aid the use in opening the mailer. Since Fabel ('661) explicitly suggests using a tear strip to aid the recipient in opening the mailing, it would have been obvious to one of ordinary skill at the time the invention was made that mailer of either Bowen et al ('069) or Elmlinger ('082) as modified by either Van Malderghem ('438) or Juszak et al ('545) or Tess ('727) or Swiercz ('410) as suggested by Fowler et al ('508) and as modified by Fabel ('661) and either Swiercz ('410) or Leibe ('337) could be further modified to include the use of a tear strip that opens from left to right and is positioned along the lower/bottom edge of the mailer as taught by either Dicker ('759) or Ashby ('000 or '612) so that the mailer is suitable for reaching the recipient and accomplishing the purpose of returning the reply of recipient to the original sender.

5.4.2 In regard to the flap in claims 105-108, 110 & 111, note flap 44 as depicted in fig. 1 of Bowen et al ('069) or flap 50 as depicted in fig. 8 of Elmlinger ('082) or flap 94 as depicted in fig. 14b of Fabel ('661) or the features of the invention designated as 14, 54, 64 & 66 in fig. 4 of Ashby ('000). It is noted that all of these flaps have the same function and have been

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formed by sealing three of the four sides of the return envelope. Since either Bowen et al ('069) or Elmlinger ('082) or Fabel ('661) or Ashby ('000) use a flap on the return envelope in order to seal the return envelope, it would have been obvious to one of ordinary skill at the time the invention was made that the flap of either Bowen et al ('069) or Elmlinger ('082) as modified by either Van Malderghem ('438) or Juszak et al ('545) or Tess ('727) or Swiercz ('410) as suggested by Fowler et al ('508) and as modified by Fabel ('661) and either Swiercz ('410) or Leibe ('337) as modified by either Dicker ('759) or Ashby ('000 or '612) could be placed on any of the sides of the return envelope absent applicant showing of new and unexpected results from positioning the flap on a particular side of the return envelope, since the function of the flap does not change based on which side of the envelope that it may appear, for as the Court has stated it is not invention to merely move the location of a device, since the new position does not affect, i.e. modify the operation of the device, (In re Japikse, 86 U.S.P.Q. 70 @ 73 (CCPA, 1950)).

5.5 Claim 109 is rejected under 35 U.S.C. § 103(a) as being unpatentable over either Smallwood et al (GB 2299036) or McCoy et al (6,409,592) as evidence by Leibe (4,770,034).

5.5.1 In regard to claim 109, either Smallwood et al ('036) or McCoy et al ('592) disclose mailer comprises of a sheet of paper having an outside and an inside surfaces and where information is printed in one or more areas on the outside surface. While the area on the inside surface are covered by two different methods. That is the inside surface is divided into a number of areas, where a security screen is used to cover the inside surface with the exception of the areas that correspond to the areas on the outside surface on which information is printed. And wherein the areas that correspond to the areas that have information printed on the outside surface are covered by a dark solid opaque medium in Smallwood et al ('036) or a white solid opaque medium in McCoy et al ('592).

5.5.2 Neither Smallwood et al ('036) nor McCoy et al ('592) disclose that the security screen placed on a sheet or ply/layer of the mailer would have the function of preventing the contents of the mailer from being scanned by external devices and/or people, however, in the environment of multiple layer/ply mailers, Leibe ('337) discloses that a printed pattern 68 on one side of one or more of the sheets that form the plies/layers of the mailer would provide this

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function. Hence, it would have been obvious to one of ordinary skill at the time of the invention, that the security screen of either Smallwood et al ('036) or McCoy et al ('592) would provide the function of preventing the contents of the mailer from being scanned by external devices and/or people as taught by Leibe ('337).

6. Response to applicant's arguments.

6.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

7. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783 (after 13 April 2005 (571) 272-6802). The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702 (after 13 April 2005 (571) 272-6812). Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

8.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

8.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

8.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

02/17/05



Edward R. Cosimano
Primary Examiner A.U. 3629